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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON, FL 33487

EXAMINER

RIVIERE, HEIDI M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/972,403	Applicant(s) ALBAZZ ET AL.	
	Examiner HEIDI RIVIERE	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/29/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-11,13-19,21-25,27,29-35 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-11,13-19,21-25,27,29-35 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/27/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 06/29/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

Response to Arguments

1. Applicant's arguments filed **6/29/2008** have been fully considered but they are not persuasive.

2. In regards to the 35 USC 101 rejection of claims 9-16: Applicant argues that the steps of storing and generating data and the step of interlocking as it applies to locking the data of the contract should be considered transformation of data and should rule out the 35 USC 101 rejection presented. There is no subject matter transformation in regards to these limitations. Stored data is merely the same subject matter stored. Generated data is merely the same subject matter generated. And interlocked data is merely the same data interlocked. The data or information is not altered or changed. Furthermore, Applicant argues that the use of a storing the contract terms, see claim 9 for example, suffices and fulfills the machine requirement of 35 USC 101. However, there is no link or reference to an actual machine. Examiner is only duty bound to analyze the claims broadly. Therefore as written the steps of claims 9-16 for example can either be accomplished as mental steps or by hand and the used of a physical filing cabinet. No machine is listed in these claims.

Furthermore, Applicant also objects to the 35 USC 101 rejection of claims 25, 27 and 29-32. Applicant argues that the processing system noted references a device and not a computer program. First of all, the specification details a processing entity and points to the contract being the "processing entity" (see pages 13 and 22) but there is no mention of a "processing system" anywhere in the specification. Considering the contract as the processing system would still make the claims non-statutory. The claims as written not only contradict the specification but they also pertain in the broadest light to a computer program with no statutory tie to a computer. These claims merely present manipulated data and are therefore non-statutory.

3. The previous 35 USC 102 rejection has been amended and the current claims are now rejected using 35 USC 103 (a). As written the arguments read that the contract is generated by storing the business rules, which can be considered terms of the agreement as well as data considered and labeled the terms and conditions. It is unclear how the steps of storing and generating links actually create a document. The Conklin reference details the storage of contract related rules and data. Please see below. The rejections below are adequately cited and detailed to enable Applicant to discern examiner's recitation. The Conklin reference does teach the interlocking of terms and rules and noting the final document as complete. Furthermore, user passwords are assigned to secure the negotiations.

Information Disclosure Statement

4. The Information Disclosure Statement filed on **8/27/2007** has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35, 37-40** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-14, 16, 20-27 and 29-35** of copending **Application No. 09/827,431**; **claims 1-3, 5-8, 10-13, 15-18 and 20** of copending **Application No. 09/972,434**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all three applications claims systems for generating a contract involving storing business rules and terms and conditions, generating links between the

rules and terms and conditions as well as interlocking the business rules, terms and conditions and the links to lock the contract. They all have a plurality of tiers, product list filters, elements that can be unilaterally filtered and product list filters.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections. 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 2-3, 5-11, 13-16, 25, 27, and 29-32** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. **With respect Claims 1, 2-3, 5-8:** An individual wishing to avoid infringement would not be reasonably made aware of the scope of the claimed invention. For example, claim 1 is directed to a system. Applicant claims that the system comprises a computer which is appropriate structure. However, applicant also includes language stating that " the contract is generated by" and has a series of steps. How is a contract a structural element in the system? What generates the contract if all the computer does is store, receive and reference information and the interface displays the information? Therefore, it is not clear what statutory class applicant's invention falls into – a method or system. Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990);

IPXL Holdings v. Amazon.com, Inc., 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005).

4. **Claims 1, 2-3, 5-8** are also confusing in that it refers to potentially three different types or sets of user interfaces. For example, claim 1 states "generate a user interface", "communicating the user interfaces", and "the user interface displays". And furthermore claim 3 states "the communications interface". Is applicant referring to one, two or three types or set of user interfaces? Where is the antecedent basis for "communicating the user interfaces"?

5. **Furthermore Claims 1, 2-3, 5-8** recites the limitation "communicating the user interfaces" and "the user interface displays" in the limitations of claim 1 and "the communications interface" in claim 3. There is insufficient antecedent basis for these limitations in the claims.

6. **With regards to claims 1, 2-3, 5-11, 13-16, 25, 27, and 29-32**, the claims as written are confusing. For example claim 9 states "communicating a user interface". How is an interface communicated? And the limitation taken as a whole reads "communicating a user interface to a contracting party, wherein the contract is generated by". Did Applicant mean to confer that instead of contract the "contracting party" is generated? Or instead of contract the "user interface" is generated?

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1, 2-3, 5-11, 13-16, 25, 27, and 29-32** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. **With regards to Claims 1, 2-3, 5-8:** 35 USC 101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above are intended to embrace or overlap **two** different statutory classes of invention as set forth in 35 USC 101. The claims use “system” in the preamble followed by structure and the method steps for generating a contract. The use of “contract is generated” is confusing when the limitations identify means for claims of a system. How is a contract a structural element in the system? What generates the contract if all the computer does is store, receive and reference information and the interface displays the information? Claims of this type are precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only”, *Ex parte Lyell* (17 USPQ2d 1548). The mention of both statutory classes in a claim renders such claims non-statutory.

7. **With regards to Claims 9-11 and 13-16:** In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials). *In re Bilski*, 545 F. 3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With

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respect to claims 9-16, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the machine that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the Bilski decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 9-16 are non-statutory since they may be preformed within the human mind.

With regards to Claims 25, 27, 29-32: Claims 25, 27, 29-32 are drawn to a processing system, fail to satisfy the requirements for statutory subject matter. These claims comprise a processing system with an interface and data in the form of a contract contained thereon which are basically software components and not an apparatus/machine as required by the 35 U.S.C. 101. There are no citations of an apparatus or structural elements or devices such as processor or computer or computer server.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35 and 37-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Conklin et al. (U.S. 6,338,050)** (Hereinafter referred to as **Conklin**) in view of **Shirley et al. (US 5/692,206)** (hereinafter "**Shirley**").

1. With respect to **Claims 1, 9, 17, 25, and 33**:

Conklin discloses:

storing the contract terms and conditions (Conklin: col. 21 – relational structuring of database; col.23 – storing of negotiations and results data; detailed rules for ordering),

receiving information (Conklin; Col. 23, lines 15-67 – desktop computer and Internet used), and

communicating a user interface to a contracting wherein the user interface displays selected information based on terms and conditions in the contract (Conklin; Col. 23, lines 15-67 – desktop computer and Internet used)

the contract is generated by:

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract, storing at least one terms and conditions set containing parameters corresponding to selected rules

from the compilation of business rules, generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract,. (Conklin: col. 21 – relational structuring of database; col.23 – storing of negotiations and results data; detailed rules for ordering);

and interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract (Conklin: cols. 19 and 21 and col. 22, lines 1-40 – authoring process integrated with databases; relational structuring of databases; “databases 225 created according to the present invention use a combination of record, filed, relational names and delimiters to interrelate the elements within; Data is kept secure with firewalls and SSL encryptions; col. 20, lines 45-65 – “the present invention protects the documents with separate user names, passwords and access levels for each inquirer”; col. 21, “Unique id's feature is used to insure the proper data is found and transmitted. That is, the present invention associates unique identifiers (id's) with each sponsor, participant, and type of data or transaction. Since database functions are integrated directly with the other functions of the invention, faster processing and updating of the database is enabled.”; col. 24, lines 15-60 - final document is noted as complete);

Conklin does not teach, however Shirley teaches referencing the terms and conditions of the contract to process the information and generate user interfaces in response (Shirley: Figs. 11a and 11b; col. 6, lines 20-60; col. 8-col.

9, line 30 – provisions are selected by authoring unit and used by user to complete document and use in Microsoft Word)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Conkling and Shirley. Both references discuss the steps involve with the generation of a contract. The references of the terms and conditions of a contract are necessary for future interpretation in case of a dispute.

2. With respect to **Claims 2 and 26**: Cancelled
3. With respect to **Claims 3, 11, 19, 27, and 35**:

Conklin discloses in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list (Conklin col. 19, lines 57-60, "Buyer processes shown in FIG. 1g include search and evaluate processes, which enable a prospective buyer to find companies and their products in the community and investigate their prices, terms and service offerings."; col. 20, lines 1-50 – catalog and price list; web server software used).

The data in which the contract contains is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material"

includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data in which the contract contains adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with

the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data in which the contract contains does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

4. With respect to **Claims 4, 12, 20, 28, and 36**: Cancelled.

5. With respect to **Claims 5, 13, 21, 29, 37**:

Conklin discloses storing at least one product list filter for generating a list of a specified subset of products from a master list of products, and generating links between the product list filter, the terms and conditions set and the master list of products (Conklin col. 21, "Unique id's feature is used to insure the proper data is found and transmitted. That is, the present invention associates unique identifiers (id's) with each sponsor, participant, and type of data or transaction. Since database functions are integrated directly with the other functions of the invention, faster processing and updating of the database is enabled."; relational names and delimiters to interrelate the elements within).

The data in which the product list is non-functional descriptive data.

6. With respect to **Claims 6, 14, 22, 30, and 38**:

Conklin discloses the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products (Conklin Fig 1g, item 70, "Search & Evaluate").

The data in which the product list is non-functional descriptive data.

7. With respect to **Claims 7, 15, 23, 31, and 39:**

Conklin discloses the contract comprises dynamic elements which can be unilaterally altered by a contracting party (Conklin col. 23, lines 37-53, “participant proposing terms to another participant on an initiating terminal (or desktop computer or workstation, etc.) over the Internet through multivariate negotiations engine system, thereby creating a communications path which is ultimately directed by multivariate negotiations engine system over the Internet to the destination terminal at which the selected other participant is active.”).

The data in which the contract contains is non-functional descriptive data.

8. With respect to **Claims 8, 16, 24, 32, and 40:**

Conklin discloses the product list filter is a dynamic element (Conklin col. 14, lines 1-29, “...allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms...”).

The data in which the product list is non-functional descriptive data.

9. With respect to **Claims 10, 18, and 35:**

Conklin discloses the user interface displays selected information based on terms and conditions in the contract (Conklin col. 14, lines 1-29, “...allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms...”).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEIDI RIVIERE whose telephone number is (571)270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. R./
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689